

Docket No. H 3497 PCT/US
Serial No. 09/856,236

10, line 12 et seq. It is well settled that the specification may be referred to in order to clarify a claim term. Since Applicants' specification clearly defines what is meant by the term "other type", it is respectfully submitted that this term is not therefore indefinite. An applicant is entitled to be his or her own lexicographer, so long as the meaning associated with the term in question is not repugnant to its usual meaning. MPEP 706.03(d).

Claim 28 has been amended to include Markush terminology. It is respectfully submitted that all of the identified items are compositions and that "surface coating" is not an article, as asserted by the Examiner. What is claimed in this instance is the composition of the coating, not an "article" coated with this composition.

With regard to claim 30, this claim has been amended in concert with claim 28. All of the listed items are, in fact, compositions. No article is being claimed.

Response to rejection under 35 USC 102(e):

Claims 12, 14-23, 25-26, 28 and 30 are rejected under 35 USC 102(e) as being anticipated by Jobbins (US 6,171,388 B1). Applicants respectfully traverse for the following reasons.

Jobbins does not teach using gypsum derived from waste-gas desulphurization plants (WDP gypsum). The statement in the rejection, on page 4 a. paragraph 5, "...the gypsum utilized in the composition can be obtained [from] waste gas desulphurization process..." is incorrect. The Examiner is cordially invited to look at column 4, lines 28-30 of this reference where Jobbins states that the gypsum to be used in his invention is "mined". This is naturally occurring gypsum. It should therefore be clear that Jobbins does not include WDP gypsum in his invention. In the

Docket No. H 3497 PCT/US
Serial No. 09/856,236

immediately preceding paragraph, Jobbins makes a general statement about various sources from which gypsum may be obtained, and includes gypsum derived from waste-gas desulphurization plants. However, this statement is merely a restatement of a well known fact and provides a contrasting backdrop for his board making process in which he clearly omits employing WDP gypsum in his invention.

Applicants respectfully take issue with the Examiner's statement, ". . .the present claims do not exclude the presence of naturally occurring gypsum...". Claim 12 clearly states that the gypsum to be used in the present invention must be "obtained from waste-gas desulphurization plants". The claims are therefore clearly limited to WDP gypsum and do, in fact, exclude naturally occurring gypsum. Applicants respectfully submit that the rejection under section 102(.) should be withdrawn.

Response to rejections under 35 USC 103(a):

Claims 15 and 19 are rejected under 35 USC 103(a) as being unpatentable over Jobbins. Applicants respectfully traverse. Jobbins utilizes titanium dioxide as a pigment. The claimed invention utilizes titanium dioxide as a filler. The reference does not disclose or suggest using titanium dioxide as a filler. Jobbins lists other compounds as fillers, but not this one. If he intended that this material might have utility as a filler, then why was this not stated since many Jobbins made a point of listing many fillers? It is respectfully submitted that since Jobbins does not teach or even suggest that titanium dioxide may be useful as a filler, it would not have been obvious to utilize it as such. Its recitation within this reference might arguably have made it "obvious to try" this substitution. However, this is not the standard for obviousness. *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276 (Fed. Cir. 1987).

Docket N . H 3497 PCT/US
Serial No. 09/856,236

Claims 13, 16, 20, 24 and 27 are rejected under 35 USC 103(a) as being unpatentable over Jobbins as previously applied to claims 12, 14-23, 25-26, 28 and 30, and further in view of Meinhardt (US 5,852,063). Applicants respectfully traverse. Meinhardt relates to a process for forming an *in situ* joining foam. As such, the polymer used is not a polymer in the sense of the present invention because the dispersion formed is not stable (kindly note page 4, lines 7-12 of the specification). Further, only particle size *diameter* is mentioned. There is no discussion about the particle size distribution of WDP (FGD) gypsum.

Jobbins does not employ gypsum as a filler (dihydrate form). He uses it as a binder (hemihydrate form) to form wallboard. While the dihydrate form is mentioned in the patent (col 4, lines 24-60), it is not prepared for the same purpose as in the Applicants' invention, as a water containing mixture or powder (kindly note page 4, lines 7-12 of the specification). Further, Jobbins does not address the problem of shrinkage as do Applicants (kindly note page 3, lines 7-24 of the specification). Applicants have discovered that by utilizing a WDP gypsum having a specific particle size distribution, this problem is resolved (kindly note Figure 2 in the specification). This factor is not evident from the disclosures of either Jobbins or Meinhardt. The withdrawal of this rejection is therefore respectfully requested.

Claims 15 and 19 are rejected under 35 USC 103(a) as being unpatentable over Jobbins as applied previously to claims 12, 14-23, 25-26, 28 and 30, and further in view of Nakamura et al.(US 5,298,542). Nakamura et al. relates to acrylic ester copolymer plastisol compositions that may be used as building material molding compositions, coating compositions or foamed products. Traditional additives for such uses are also disclosed. Gypsum is mentioned only as a secondary filler to the plastisol composition. It is respectfully submitted that Nakamura et al. fail to make up for the deficiencies of Jobbins. No one of skill in the art would have been motivated

Docket No. H 3497 PCT/US
Serial No. 09/856,236

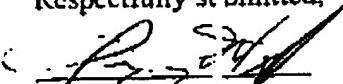
to combine the plastisol containing building material of Nakamura et al with the naturally occurring gypsum of Jubbins to come up with Applicants' invention. The motivation to make this combination is absent from the teachings of these references. The withdrawal of this rejection is therefore respectfully requested.

CONCLUSION

Applicants request that the shortened statutory period to respond to the Office Action, mailed October 23, 2002, be extended one month from January 23, 2003 to February 23, 2003. Please charge our Deposit Account No. 01-1250 in the amount of \$110.00 for the extension fee. Order No. 03-0060

For the foregoing reasons, it is respectfully submitted that the claims, as amended, now present patentable subject matter. Accordingly, Applicants respectfully request the issuance of a notice of allowance. The Commissioner is hereby authorized to charge any deficiency in the required fee or to credit any overpayment in connection with this amendment to Deposit Account 01-1250.

Respectfully submitted,


Gregory M. Hill
(Reg. No. 31,359)
Attorney for Applicant(s)
(610) 278-4961

Henkel Corporation
Patent Department
2500 Renaissance Blvd., Suite 200
Gulph Mills, PA 19406

Docket No. H 3497 PCT/US
Serial No. 09/856,236

VERSION WITH MARKINGS TO SHOW CHANGE; MADE

In the Claims:

The following claims have been amended as shown below:

14. (amended) The composition of claim 13, wherein the filler particles comprise at least one other type of inorganic filler particles in addition to the WDP gypsum particles.

28. (amended) A process for preparing a composition selected from the group consisting of a surface coating, a surfacing compound, a sealing compound, an adhesive, and [or] a molding composition comprising combining one or more water soluble or water-dispersible polymers with WDP gypsum particle; wherein the WDP gypsum particles are obtained from waste-gas desulphurization plants and have a particle size distribution mean diameter ranging from 13 μm to 500 μm to form the composition [surface coating, surfacing compound, sealing compound, adhesive, or molding composition].

30. (amended) A composition selected from the group consisting of a surface coating, a surfacing compound, a sealing compound, an adhesive, and [or] a molding composition prepared by the process of claim 28.